Remarks

Claims 1 and 8 to 35 were pending and before the Examiner. By this Amendment, claims 1, 18 to 20, 24 to 26, and 29 have been amended. As no new matter has been added thereby, entry of the amendments are respectfully requested. Claims 1 and 8 to 35, as amended, are now pending and before the Examiner. Applicants again point out that similar issues (e.g., concerning the enablement of "prevention" in the claims) are present and similar rejections have been made in copending U.S.S.N. 10/757,295, which is also being examined by the Examiner.

The Examiner rejected claims 1, 8 to 13, 18 to 20, and 24 to 35 as allegedly failing to comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

In response, applicants have amended claims 1, 18 to 20, 24 to 26, and 29 and maintain that such amendments render the Examiner's rejection moot. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner rejected claims 1 and 8 to 17 as allegedly failing to provide enablement under 35 U.S.C. § 112, first paragraph, for (1) the prevention of the recited conditions, or (2) the use of telmisartan polymorphs.

In response, applicants have amended claims 1, 18 to 20, 24 to 26, and 29 and maintain that such amendments render the Examiner's rejection concerning telmisartan polymorphs moot. In addition, applicants traverse the rejection of the claims directed to prevention as improper. "When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement". *In re Wright*, 27 U.S.P.Q. 1510, 1513 (Fed. Cir. 1993)(emphasis added).

The Examiner again alleges that the term "prevent" requires absolute success and that this is the "broadest reasonable interpretation". Applicants maintain that this is an unreasonable interpretation of the meaning of prevention, is contrary to what one of ordinary skill in the art

would understand "prevent" to mean in the context of the invention, and is accordingly improper. The reasoning of *Ex parte Cho*, Appeal No. 2001-2646 (Bd. Pat. App. & Int. 2002)(nonprecedential) is particularly compelling for the instant claims which are directed to a discrete combination of two very well-known chemical entities. As the Board stated, "Logically, if the recited compounds are useful for treating conditions such as pain and inflammation once they exist, they would also be expected to be effective in preventing pain and inflammation, if they were administered before the onset of pain or inflammation." (emphasis in original) is a generalized statement not limited to the specific technology of *Ex parte Cho* and there is no apparent concern for enablement about how such patients could be identified. Furthermore, the applicant in *Ex parte Cho* was claiming a "broad genus of compounds", which would make Cho's successful showing of enablement even more difficult than the instant claims. The Examiner concedes enablement of the instant claimed combination for treatment of the recited conditions, which would make the logical generalization of *In re Cho* even more obviously on point. Unreasonable interpretations of claim terms are the basis for reversal of the Office. See *In re Buszard*, – F.3d –, 207 WL 2791699 (Fed. Cir. September 27, 2007)(Board's claim interpretation was not reasonable and accordingly rejection reversed); see also *Ex parte Konieczynski*, Appeal No. 2007-1707 (Bd. Pat. App. & Int. 2007)(nonprecedential)(Examiner's claim interpretation was not reasonable and accordingly rejection reversed). Enablement, of course, does not require perfection, satisfaction of every remote speculation by the Examiner, or impossible standards.

The essential point is that such suitable patients having symptoms or conditions amenable to preventive treatment and the pharmaceutical is administered to such patients, the pharmaceutical would be expected to have a prophylactic effect based on the demonstrated biological activity. Such would be expected to be the reasoning used in order to obtain regulatory approval for such a pharmaceutical, which is certainly more strict than is required for satisfaction of the enablement requirement. The Examiner's speculation that some suitable patients might not be identified for preventive treatment or that suitable patients might not benefit does not detract from this conclusion as absolute success is not required for enablement of such claims any more than it is required to enable other treatment claims. The Office has been repeatedly reversed for rejecting for lack of enablement claims directed to compounds having demonstrated pharmaceutical and biological activity. *See* M.P.E.P.

§ 2107 (particularly §§ 2107.01 III/IV and 2107.03, discussing the relationship of the utility and enablement requirements and the role of the FDA) and § 2164 (particularly § 2164.06).

The FDA is the agency charged with approving new drug products for human use in the United States. In order to get approval for such new drug products, applicants must clinically demonstrate the safety and efficacy of their products for certain therapeutic indications to the satisfaction of the FDA before marketing them for those approved indications, including prevention indications. In one well-known example, the FDA approved the use of aspirin for the prevention of stroke in men and women who have already had an ischemic stroke or mini-stroke (see http://www.fda.gov/cder/news/aspirin/aspirin_QA.htm). This indication for prevention was approved by the FDA despite the fact that aspirin is not absolutely effective in the prevention of stroke for such patients nor does this indication somehow require that every single potential patient who could benefit from such therapy be identified. Nor is this situation unique, but is common. The FDA's *Approved Drug Products with Therapeutic Equivalence Evaluations* publication (also known as the "Orange Book" and located online here: http://www.fda.gov/cder/orange/obannual.pdf, cumulative supplement here: http://www.fda.gov/cder/orange/obcs.pdf). As the Orange Book Preface states "identifies drug products approved on the basis of safety and effectiveness by the Food and Drug Administration (FDA) under the Federal Food, Drug, and Cosmetic Act (the Act)." Among other things, drug products having new FDA-approved indications are assigned Indication Exclusivity Codes, which you can see below include a significant number of which involve indications for prevention of certain conditions (full list at http://www.accessdata.fda.gov/scripts/cder/ob/docs/excltermsall.cfm).

Selection of Orange Book Indication Exclusivity Codes and Indications	
I-9	PREVENTION OF POSTOPERATIVE NAUSEA AND VOMITING
I-10	PREVENTION OF POSTOPERATIVE DEEP VENOUS THROMBOSIS AND PULMONARY EMBOLISM IN TOTAL HIP REPLACEMENT SURGERY
I-64	PREVENTION OF SUPRAVENTRICULAR TACHYCARDIAS
I-65	PREVENTION OF UPPER GASTROINTESTINAL BLEEDING IN CRITICALLY ILL PATIENTS

I-72	PREVENTION OF CMV DISEASE IN TRANSPLANT PATIENTS AT RISK FOR CMV DISEASE
I-76	PREVENTION OF OSTEOPOROSIS
I-81	PROPHYLAXIS IN DESIGNATED IMMUNOCOMPROMISED CONDITIONS TO REDUCE THE INCIDENCE OF OROPHARYNGEAL CANDIDIASIS
I-93	PREVENTION OF EXERCISE-INDUCED BRONCHOSPASM IN CHILDREN AGES 4-11 YEARS
I-103	PROPHYLAXIS AGAINST PNEUMOCYSTIS CARINII PNEUMONIA IN INDIVIDUALS WHO ARE IMMUNOCOMPROMISED AND CONSIDERED TO BE AT RISK OF DEVELOPING PNEUMOCYSTIS CARINII PNEUMONIA
I-110	PREVENTION OF NAUSEA AND VOMITING ASSOCIATED WITH RADIOTHERAPY
I-118	PREVENTION OF DEEP VEIN THROMBOSIS, WHICH MAY LEAD TO PULMONARY EMBOLISM, FOLLOWING KNEE REPLACEMENT SURGERY
I-137	PREVENTION OF MEAL-INDUCED HEARTBURN, ACID INDIGESTION, AND SOUR STOMACH WHEN TAKEN 30 MINUTES PRIOR TO CONSUMING FOOD OR BEVERAGES
I-140	PREVENTION OF CYTOMEGALOVIRUS (CMV) DISEASE IN INDIVIDUALS WITH HIV INFECTION AT RISK FOR DEVELOPING CMV DISEASE
I-147	PREVENTION OF GALLSTONE FORMATION IN OBESE PATIENTS EXPERIENCING RAPID WEIGHT LOSS
I-170	PROPHYLACTIC USE DURING HEAD LICE EPIDEMICS
I-173	PREOPERATIVELY FOR THE PREVENTION OF INFECTION IN TRANSRECTAL PROSTATE BIOPSY
I-185	PREVENTION OF OSTEOPOROSIS IN POSTMENOPAUSAL WOMEN
I-187	PREVENTION OF FRACTURES IN THE TREATMENT OF POSTMENOPAUSAL OSTEOPOROSIS
I-192	THE PREVENTION OF DEEP VEIN THROMBOSIS, WHICH MAY LEAD TO PULMONARY EMBOLISM, IN PATIENTS UNDERGOING ABDOMINAL SURGERY WHO ARE AT RISK FOR THROMBOEMBOLIC COMPLICATIONS AND A NEW DOSAGE REGIMEN, 40MG ONCE DAILY, FOR THIS INDICATION
I-217	PREVENTION (DURING AND FOLLOWING HOSPITALIZATION) OF DEEP VEIN THROMBOSIS, WHICH MAY LEAD TO PULMONARY EMBOLISM, IN PATIENTS UNDERGOING HIP REPLACEMENT SURGERY
I-222	PREVENTION OF ISCHEMIC COMPLICATIONS OF UNSTABLE ANGINA AND NON-Q-WAVE MYOCARDIAL INFARCTION, WHEN CONCURRENTLY ADMINISTERED

	WITH ASPIRIN
I-228	PREVENTION OF MEAL INDUCED HEARTBURN AT A DOSE OF 75MG TAKEN 30-60 MIN PRIOR TO A MEAL
I-233	PROPHYLACTIC USE TO REDUCE PERIOPERATIVE BLOOD LOSS AND THE NEED FOR BLOOD TRANSFUSION IN PATIENTS UNDERGOING CARDIOPULMONARY BYPASS IN THE COURSE OF CORONARY ARTERY BYPASS GRAFT SURGERY
I-235	PREVENTION OF EXERCISE-INDUCED BRONCHOSPASM IN PATIENTS 12 YEARS OF AGE AND OLDER
I-236	PREVENTION OF EXERCISE-INDUCED BRONCHOSPASM IN PATIENTS 4 YEARS OF AGE AND OLDER
I-244	REDUCE THE INCIDENCE OF BREAST CANCER IN WOMEN AT HIGH RISK FOR BREAST CANCER
I-250	PRIMARY PREVENTION OF CORONARY HEART DISEASE IN PATIENTS WITHOUT SYMPTOMATIC CARDIOVASCULAR DISEASE WHO HAVE AVERAGE TO MODERATELY ELEVATED TOTAL-C AND LDL-C AND BELOW AVERAGE HDL-C
I-254	PREVENTION OF POSTMENOPAUSAL OSTEOPOROSIS (LOSS OF BONE MASS)
I-255	PREVENTION OF PNEUMOCYSTIS CARINII PNEUMONIA (PCP)
I-259	PROPHYLAXIS OF DEEP VEIN THROMBOSIS (DVT), WHICH MAY LEAD TO PULMONARY EMBOLISM, IN PATIENTS UNDERGOING HIP REPLACEMENT SURGERY
I-262	TREATMENT OR PREVENTION OF BRONCHOSPASM WITH REVERSIBLE OBSTRUCTIVE AIRWAY DISEASE AND FOR THE PREVENTION OF EXERCISE INDUCED BRONCHOSPASM IN CHILDREN AGES 4-12
I-264	PREVENTION OF NAUSEA AND VOMITING ASSOCIATED WITH RADIATION, INCLUDING TOTAL BODY IRRADIATION (TBI) AND FRACTIONATED ABDOMINAL RADIATION
I-268	PROPHYLAXIS AND CHRONIC TREATMENT OF ASTHMA IN PATIENTS 7-11 YEARS OF AGE
I-269	PREVENTION OF NAUSEA AND VOMITING ASSOCIATED WITH HIGHLY EMETOGENIC CANCER CHEMOTHERAPY, INCLUDING CISPLATIN
I-280	USE OF CARNITOR INJECTION FOR THE PREVENTION AND TREATMENT OF CARNITINE DEFICIENCY IN PATIENTS WITH END STAGE RENAL DISEASE WHO ARE UNDERGOING DIALYSIS
I-283	TO REDUCE THE INCIDENCE OF MODERATE TO SEVERE XEROSTOMIA IN PATIENTS UNDERGOING POST-OPERATIVE RADIATION TREATMENT FOR HEAD AND NECK CANCER, WHERE THE RADIATION PORT INCLUDES A SUBSTANTIAL

	PORTION OF THE PAROTID GLANDS
I-284	TO REDUCE THE NUMBER OF ADENOMATOUS COLORECTAL POLYPS IN FAMILIAL ADENOMATOUS POLYPOSIS PATIENTS AS AN ADJUNCT TO USUAL CARE
I-287	USE OF PRAVASTATIN IN PATIENTS WITH EVIDENT CORONARY HEART DISEASE TO REDUCE THE RISK OF TOTAL MORTALITY BY REDUCING CORONARY DEATH
I-291	PREVENTION OF POSTMENOPAUSAL OSTEOPOROSIS
I-295	PREVENTION OF POSTMENOPAUSAL OSTEOPOROSIS FOR WOMEN WITH AN INTACT UTERUS
I-300	PROPHYLAXIS FOR ASTHMA IN CHILDREN 2-5 YEARS OF AGE
I-310	REDUCTION IN RISK OF MYOCARDIAL INFARCTION, STROKE, AND DEATH FROM CARDIOVASCULAR CAUSES
I-317	PROPHYLAXIS OF INFLUENZA IN ADULTS AND ADOLESCENTS 13 YEARS AND OLDER
I-325	PREVENTION OF RELAPSE AND RECURRENCE OF DEPRESSION
I-328	PROPHYLAXIS AND CHRONIC TREATMENT OF ASTHMA IN PATIENTS 5-6 YEARS OF AGE
I-347	TREATMENT OR PREVENTION OF BRONCHOSPASM IN CHILDREN 6 YEARS OF AGE AND OLDER WITH OBSTRUCTIVE AIRWAY DISEASE
I-351	PREVENTION OF POSTMENOPAUSAL OSTEOPOROSIS FOR ALL STRENGTHS
I-366	PREVENTION OF RELAPSE FOLLOWING LONG-TERM TREATMENT OF MAJOR DEPRESSIVE DISORDER
I-369	PREVENTION AND TREATMENT OF POSTOPERATIVE NAUSEA AND VOMITING
I-371	HELICOBACTER PYLORI ERADICATION TO REDUCE THE RISK OF DUODENAL ULCER RECURRENCE
I-397	EXTENDED PROPHYLAXIS IN PATIENTS UNDERGOING HIP FRACTURE SURGERY
I-403	USE OF VALTREX IN COMBINATION WITH SAFER SEX PRACTICES FOR THE REDUCTION OF THE RISK OF TRANSMISSION OF GENITAL HERPES DURING SUPPRESIVE THERAPY OF THE SOURCE PARTNER IN A HETEROSEXUAL COUPLE
I-406	PREVENTION OF CYTOMEGALOVIRUS DISEASE IN KIDNEY, HEART, AND KIDNEY-PANCREAS TRANSPLANT PATIENTS AT HIGH RISK (DONOR CMV SEROPOSITIVE/RECIPIENT CMV SERONEGATIVE)

I-407	IMPROVE SURVIVAL OF STABLE PATIENTS WITH LEFT VENTRICULAR SYSTOLIC DYSFUNCTION (EJECTION FRACTION<=40%) AND CLINICAL EVIDENCE OF CONGESTIVE HEART FAILURE AFTER AN ACUTE MYOCARDIAL INFARCTION
I-414	PROPHYLAXIS OF DEEP VEIN THROMBOSIS (DVT), WHICH MAY LEAD TO PULMONARY EMBOLISM (PE) IN MEDICAL PATIENTS WHO ARE AT RISK FOR THROMBOEMBOLIC COMPLICATIONS DUE TO SEVERELY RESTRICTED MOBILITY DURING ACUTE ILLNESS
I-434	PREVENTION OF CARDIOVASCULAR DISEASE IN ADULT PATIENTS WITHOUT CLINICALLY EVIDENT HEART DISEASE, BUT WITH MULTIPLE RISK FACTORS FOR CORONARY HEART DISEASE TO REDUCE RISK OF MI AND RISK FOR REVASCULARIZATION PROCEDURES AND ANGINA
I-448	TREATMENT OF HEART FAILURE (NYHA CLASS II-IV AND EJECTION FRACTION <=40%) TO REDUCE THE RISK OF DEATH FROM CARDIOVASCULAR CAUSES AND TO REDUCE HOSPITALIZATIONS FOR HEART FAILURE
I-456	TO REDUCE CARDIOVASCULAR DEATH AND TO REDUCE HEART FAILURE HOSPITALIZATIONS. INCLUDES ADDITIONAL INFORMATION ON THE ADDED EFFECT ON THESE OUTCOMES WHEN USED WITH AN ACE INHIBITOR
I-471	INDICATED TO REDUCE THE RISK OF MYOCARDIAL INFARCTION AND STROKE IN PATIENTS WITH TYPE 2 DIABETES AND WITHOUT CLINICALLY EVIDENT CORONARY HEART DISEASE BUT WITH MULTIPLE RISK FACTORS FOR CORONARY HEART DISEASE
I-475	PREVENTION OF NAUSEA AND VOMITTING ASSOCIATED WITH INITIAL AND REPEAT COURSES OF MODERATELY EMETOGENIC CANCER CHEMOTHERAPY
I-480	PROPHYLAXIS OF INFLUENZA FOR PATIENTS BETWEEN 1-12 YEARS OF AGE
I-483	PREVENTION OF POSTMENOPAUSAL OSTEOPOROSIS
I-484	FOR THE RISK REDUCTION OF NSAID-ASSOCIATED GASTRIC ULCERS
I-491	INFLUENZA PROPHYLAXIS
I-497	PREVENTION OF SEASONAL MAJOR DEPRESSIVE EPISODES IN PATIENTS WITH SEASONAL AFFECTIVE DISORDER
I-498	PREVENTION OF POSTOPERATIVE NAUSEA AND VOMITING
I-515	PROPHYLAXIS OF SURGICAL SITE INFECTION FOLLOWING ELECTIVE COLORECTAL SURGERY
I-523	USE IN ADULT PATIENTS WITH CLINICALLY EVIDENT CORONARY HEART DISEASE TO REDUCE THE RISK OF NONFATAL MYOCARDIAL INFARCTION, FATAL AND NONFATAL STROKE, ANGINA, REVASCULARIZATION PROCEDURES AND HOSPITALIZATION FOR CONGESTIVE HEART FAILURE

I-525	USE OF 0.5MG/0.1MG FOR PREVENTION OF POST-MENOPAUSAL OSTEOPOROSIS
I-530	PREVENTION OF EXERCISE-INDUCED BRONCHOCONSTRICTION IN PATIENTS 15 YEARS OF AGE AND OLDER
I-539	REDUCTION IN RISK OF INVASIVE BREAST CANCER IN POSTMENOPAUSAL WOMEN WITH OSTEOPOROSIS OR AT HIGH RISK FOR INVASIVE BREAST CANCER
I-556	PREVENTION OF POST OPERATIVE NAUSEA AND VOMITING FOR UP TO 24 HOURS FOLLOWING SURGERY

Similarly, the Orange Book lists Patent Use Codes to designate a use patent that covers the approved indication or use of a drug product, which you can see below include a significant number of which involve indications for prevention of certain conditions (full list at http://www.accessdata.fda.gov/scripts/cder/ob/docs/pattermsall.cfm).

Selection of Orange Book Patent Use Codes and Indications	
U-1	PREVENTION OF PREGNANCY
U-2	TREATMENT OR PROPHYLAXIS OF ANGINA PECTORIS AND ARRHYTHMIA
U-4	PROVIDING PREVENTION AND TREATMENT OF EMESIS AND NAUSEA IN MAMMALS
U-11	TREATMENT OR PROPHYLAXIS OF CARDIAC DISORDERS
U-14	ADJUNCTIVE THERAPY FOR THE PREVENTION AND TREATMENT OF HYPERAMMONEMIA IN THE CHRONIC MANAGEMENT OF PATIENTS WITH UREA CYCLE ENZYMOPATHIES
U-112	CONTRACEPTION
U-120	CONTROLLING OR PREVENTING POST-OPERATIVE INTRAOCULAR PRESSURE RISES ASSOCIATED WITH OPHTHALMIC LASER SURGICAL PROCEDURES
U-233	DECREASING MORTALITY CAUSED BY CONGESTIVE HEART FAILURE
U-287	TREATMENT OR PREVENTION OF OSTEOPOROSIS
U-290	INHIBITING TRANSPLANT REJECTION USING RAPAMYCIN (SIROLIMUS)
U-291	INHIBITING TRANSPLANT REJECTION USING RAPAMYCIN (SIROLIMUS) IN COMBINATION WITH CYCLOSPORIN

U-292	INHIBITING TRANSPLANT REJECTION USING RAPAMYCIN (SIROLIMUS) IN COMBINATION WITH AZATHIOPRINE
U-293	INHIBITING TRANSPLANT REJECTION USING RAPAMYCIN (SIROLIMUS) IN COMBINATION WITH A CORTICOSTEROID
U-297	PREVENTION OR TREATMENT OF REVERSIBLE VASOCONSTRICTION BY THE INHALATION OF NITRIC OXIDE WITH AN OXYGEN CONTAINING GAS
U-303	METHOD OF USE PATENT-PRODUCT APPROVED FOR TREATMENT OF OSTEOPORISIS, PAGET'S DISEASE, PREVENTION AND TREATMENT OF GLUCOCORTICOID-INDUCED OSTEOPOROSIS
U-320	INHIBITING OR ELIMINATING ACUTE MYELOID LEUKEMIA
U-332	TREATMENT OR PREVENTION OF BRONCHOSPASM
U-335	USE OF PRAVASTATIN SODIUM FOR SECONDARY PREVENTION OF CORONARY EVENTS IN MEN AND WOMEN WHO HAVE HAD A MYOCARDIAL INFARCTION AND HAVE NORMAL CHOLESTEROL LEVELS
U-344	METHOD FOR INHIBITING HIV INFECTION BY ADMINISTERING RITONAVIR IN COMBINATION WITH ANOTHER HIV PROTEASE INHIBITOR
U-348	METHOD OF USE FOR INHIBITING HIV INFECTION
U-353	PREVENTION AND TREATMENT OF OSTEOPOROSIS
U-426	PREVENTION OF PREMATURE LH SURGES IN WOMEN UNDERGOING CONTROLLED OVARIAN STIMULATION
U-438	TREATMENT/PREVENTION OF NEURODEGENERATIVE DISEASE
U-528	PREVENTION OF CHEMOTHERAPY-INDUCED NAUSEA AND VOMITING
U-545	METHOD FOR THE PREVENTION AND/OR TREATMENT OF THROMBOTIC EPISODES, SUCH AS MYOCARDIAL INFARCTION, IN A HUMAN PATIENT AND METHOD FOR THE PREVENTION OF VENOUS THROMBOSIS IN A POSTOPERATIVE HUMAN PATIENT
U-574	PROPHYLAXIS AND TREATMENT OF THE NASAL SYMPTOMS OF SEASONAL ALLERGIC RHINITIS AND TREATMENT OF THE NASAL SYMPTOMS OF PERENNIAL ALLERGIC RHINITIS IN ADULTS AND PEDIATRIC PATIENTS 12 YEARS OF AGE AND OLDER
U-594	PREVENTION OF POSTMENOPAUSAL OSTEOPOROSIS
U-595	35 MG ORALLY ONCE A WEEK FOR PREVENTION OF OSTEOPOROSIS IN POSTMENOPAUSAL WOMEN; 35 MG ORALLY ONCE A WEEK FOR TREATMENT OF

	OSTEOPOROSIS IN POSTMENOPAUSAL WOMEN
U-598	PROPHYLACTIC TREATMENT OF MIGRAINE
U-624	REDUCTION OF RISK OF UPPER GASTROINTESTINAL BLEEDING IN CRITICALLY ILL PATIENTS
U-642	TREATMENT AND PREVENTION OF OSTEOPOROSIS
U-657	PREVENTION OF OSTEOPOROSIS IN POSTMENOPAUSAL WOMEN
U-671	PREVENTION AND TREATMENT OF SECONDARY HYPERPARATHYROIDISM ASSOCIATED WITH CHRONIC KIDNEY DISEASE (CKD) STAGE 3 AND 4
U-675	PROPHYLAXIS AND CHRONIC TREATMENT OF ASTHMA; RELIEF OF SYMPTOMS OF ALLERGIC RHINITIS
U-683	PREVENTION OR TREATMENT OF ISCHEMIC HEART DISEASE
U-692	USE OF VALSARTAN TO REDUCE CARDIOVASCULAR MORTALITY IN CLINICALLY STABLE PATIENTS WITH LEFT VENTRICULAR FAILURE OR LEFT VENTRICULAR DYSFUNCTION FOLLOWING MYOCARDIAL INFARCTION
U-700	TREATMENT AND PREVENTION OF OSTEOPOROSIS IN POSTMENOPAUSAL WOMEN
U-716	THE TREATMENT OR PREVENTION OF BRONCHOSPASM IN ADULTS AND CHILDREN 4 YEARS OF AGE AND OLDER WITH REVERSIBLE OBSTRUCTIVE AIRWAYS DISEASE AND THE PREVENTION OF EXERCISED-INDUCED BRONCHOSPASM IN PATIENTS 4 YEARS OF AGE AND OLDER
U-717	METHOD OF RELIEVING OR PREVENTING CONSTIPATION IN A HUMAN CONSTIPATED PATIENT
U-722	PROPHYLAXIS OF INFLUENZA
U-723	PROPHYLACTIC TREATMENT OF MIGRAINE
U-729	TREATMENT OF GASTROESOPHAGEAL REFLUX DISEASE (GERD), RISK-REDUCTION OF NSAID-ASSOCIATED GASTRIC ULCER, H. PYLORI ERADICATION

	TO REDUCE THE RISK OF DUODENAL ULCER RECURRENCE
U-745	TREATMENT OR PREVENTION OF EMESIS
U-746	PREVENTION OR TREATMENT OF NAUSEA OR EMESIS INDUCED BY A CANCER CHEMOTHERAPEUTIC AGENT
U-747	PREVENTION OR TREATMENT OF POST-OPERATIVE NAUSEA AND VOMITING
U-760	PROPHYLAXIS OF INVASIVE ASPERGILLUS AND CANDIDA INFECTIONS AND TREATMENT OF OROPHARYNGEAL CANDIDAIASIS
U-787	MAINTENANCE TREATMENT OF ASTHMA AS PROPHYLACTIC THERAPY IN ADULT AND PEDIATRIC PATIENTS SIX YEARS OF AGE OR OLDER, INCLUDING PATIENTS REQUIRING ORAL CORTICOSTEROID THERAPY FOR ASTHMA
U-798	TREATMENT AND PREVENTION OF OSTEOPOROSIS IN POSTMENOPAUSAL WOMEN BY ONCE-MONTHLY ORAL ADMINISTRATION OF IBANDRONATE SODIUM MONOHYDRATE EQUIVALENT TO 150MG OF IBANDRONIC ACID
U-807	PREVENTION OF EXERCISE-INDUCED BRONCHOCONSTRICTION
U-825	USE FOR PREVENTION OF BREAST CANCER
U-828	PREVENTION OF PREGNANCY IN WOMEN WHO ELECT TO USE ORAL CONTRACEPTIVES AS A METHOD OF CONTRACEPTION
U-850	PREVENTION OR TREATMENT OF NAUSEA OR EMESIS INDUCED BY A CANCER CHEMOTHERAPEUTIC AGENT
U-853	TREATMENT OR PREVENTION OF EMESIS
U-854	PREVENTION OF CMV DISEASE IN KIDNEY, HEART, AND KIDNEY-PANCREAS TRANSPLANT PATIENTS AT HIGH RISK (DONOR CMV SEROPOSITIVE/RECIPIENT CMV SERONEGATIVE)
U-857	INHIBITION OF TRANSPLANT REJECTION
U-871	METHOD OF REDUCING RISK OF MYOCARDIAL INFARCTION, STROKE AND

	DEATH
U-879	A METHOD OF TREATING OR PREVENTING ILEUS
U-887	TREATMENT AND PREVENTION OF OSTEOPOROSIS

Accordingly, this voluminous evidence of how one of skill in the art would interpret claims to prevention in the context of the pharmaceutical and medical arts directly contradicts the Examiner's allegation that prevention would be understood to require absolute success, since none of these approved prevention methods was required to demonstrate absolute success for FDA approval. Therefore, applicants maintain that this is an unreasonable interpretation of the meaning of prevention, is contrary to what one of ordinary skill in the art would understand "prevent" to mean in the context of the invention, and is accordingly improper. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

The Examiner also rejected claims 1 and 8 to 17 as allegedly indefinite under 35 U.S.C. § 112, second paragraph.

In response, applicants have amended claim 1 and maintain that such amendment renders the Examiner's rejection moot. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

The Examiner also again rejected claims 1 and 8 to 35 as allegedly unpatentable under 35 U.S.C. § 103(a) over De Gasparo *et al.*, in light of Robl *et al.*, in view of Cecil's Textbook of Medicine (2000), Harlan *et al.* (U.S. Patent Appl. Pub. No. 2001/0006656), and Bohm *et al.* (WO 02/15891).

Applicants again respectfully traverse the rejection. De Gasparo *et al.* does not specifically disclose the specific combination of telmisartan and simvastatin anywhere. The teachings and statements in De Gasparo *et al.* must be considered in context and interpreted as a whole. De Gasparo *et al.* does not give any preference to any particular combination within the broad

disclosure, certainly not a specific combination of telmisartan and simvastatin. Indeed, De Gasparo *et al.*, at page 3, line 22, merely defines "AT_1 receptor antagonists" as including a number of commercially available sartans including telmisartan, which is not disclosed as a selected compound in the context of a specific combination, much less with simvastatin. The only sartan specifically mentioned in De Gasparo *et al.* in the context of a specific combination is valsartan which actually teaches away from telmisartan as a preferred combination partner. Similarly, in De Gasparo *et al.*, simvastatin is mentioned on page 5, lines 7 and 10, but not in the context of a specific combination, much less with telmisartan. On page 5, line 27, and page 6, line 1, De Gasparo *et al.* teaches that simvastatin is a preferred or most preferred composition partner with valsartan (not telmisartan), again teaching away from telmisartan as a preferred combination partner of simvastatin. Instead De Gasparo *et al.* on page 6, lines 8 and 11 refer to a combination of statins such as simvastatin with ACE inhibitors while there is no analogous teaching with regard to AT_1 receptor antagonists. The Examiner argues that this does not amount to a teaching away from the claimed invention, but applicants respectfully disagree if the full context is considered.

Furthermore, none of Robl *et al.*, Cecil's Textbook of Medicine, Harlan *et al.*, or Bohm *et al.* provide what De Gasparo *et al.* lacks in providing to one of skill in the art a motivation, reasonable expectation of success, or teaching or suggestion of all of the claim limitations of the claimed invention.

First, Robl *et al.* does not teach structures which encompass simvastatin, does not teach combinations of simvastatin with any compound except for the class of HMG-CoA reductase inhibitors claimed, and does not mention telmisartan. Second, the teaching of Harlan *et al.* is confined to aerosol formulations of statins while said formulations are not intended to combine a statin such as simvastatin with an antihypertensive much less with telmisartan. Third, the teaching of Bohm *et al.* is confined to a combination of telmisartan with the ACE inhibitor ramipril, i.e., to two active ingredients acting on the renin-angiotensin system but not on HMG-CoA reductase. Fourth, Cecil's Textbook of Medicine neither mentions telmisartan nor simvastatin. Finally, neither De Gasparo *et al.*, Robl *et al.*, Cecil's Textbook of Medicine, Harlan *et al.*, nor Bohm *et al.* teach or suggest that telmisartan increases the expression of genes regulated by the PPARgamma receptor, i.e., an activity known from antidiabetic drugs, which is the reason that telmisartan is a preferred combination partner for

simvastatin in the treatment of, e.g., diabetes, and this metabolic activity appears to be unique for telmisartan and is not recognized in the prior art. Indeed, De Gasparo *et al.* teaches the use of AT_1 receptor antagonists of "differing structural features" and therefore suggests that the specific chemical structure is of no concern and none of the other art cited makes up for this defect. Furthermore, neither Harlan *et al.* (disclosing an aerosol formulation of statins) nor Bohm *et al.* (disclosing a combination of telmisartan with ACE inhibitors) disclose, suggest, or hint at telmisartan combinations with statins and it is unclear why or how one of skill in the art at the time the claimed invention was made would combine their teachings with De Gasparo *et al.* Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner also again provisionally rejected claims 2 and 7 to 18 for nonstatutory obviousness-type double patenting over claims 1 and 8 to 35 of U.S.S.N. 10/757,015, in view of Harlan *et al.*; provisionally rejected claims 2, 7 to 11, and 14 to 18 for nonstatutory obviousness-type double patenting over claims 1 to 10, 12 to 15, and 18 to 25 of U.S.S.N. 10/899,784; and provisionally rejected claims 2, 7, and 12 to 18 for nonstatutory obviousness-type double patenting over claims 1 to 21 of U.S.S.N. 11/300,947 in view of Drug Facts and Comparisons (1996).

In response, applicants undertake to file a terminal disclaimer with respect to U.S.S.N. 10/757,295, U.S.S.N. 10/899,784, or U.S.S.N. 11/300,947, if (1) the instant claims be found otherwise allowable, and (2) applicants determine that such application poses a double patenting issue at that time. Since the scope of the claims may change and moot these provisional rejections, there is not need to address these issues at this time. Accordingly, applicants again respectfully request that the Examiner withdraw these provisional rejections for consideration later.

Applicants submit that all the pending claims are allowable and respectfully solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Respectfully submitted,

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